

REMARKS

The present application includes pending claims 1-37, all of which have been rejected. In particular, claims 1-37 stand rejected under 35 U.S.C. 102(e) as being anticipated by U.S. 2002/0112239 (“Goldman”). Without conceding that Goldman qualifies as prior art under 35 U.S.C. 102(e), the Applicants respectfully traverse these rejections for at least the reasons previously discussed during prosecution and the following.

“A claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in **a single prior art reference.**” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). “The **identical** invention must be shown in as complete detail as is contained in ... the claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (emphasis added).

I. **Goldman Does Not Anticipate Claims 1-8**

Independent claim 1 recites, in part, the following:

determining, at the first location, whether the associated set of pre-defined characteristics [associated with the requested media] matches the at least one parameter [related to monitoring media consumption activity of the user at the first location];

sending notification of the media request to a second location, via a communication network, if the determining results in a match; and

refraining from sending a notification of the media request to the second location, via the communication network, if the determining does not result in a match.

Goldman “relates to displaying information to viewers regarding the number of other viewers who are watching specified television programs.” *See* Goldman at [0003]. In particular, Goldman “relates to using a back channel to gather statistics relating to real time viewing

behavior and using the gathered information to modify electronic program guides (EPGs) so as to inform viewers of the number of other viewers who are watching the television programs.” *See id.* In short, television viewing habits are assessed, and collective viewing stats are shown on EPGs. *See id.* at [0009] (“The present invention relates to systems and method for utilizing a back channel as a feedback system to reveal what other television viewers are watching at a given moment.”).

Goldman discloses that home entertainment systems track whether a broadcast is viewed or recorded.

Home entertainment system 90 tracks each time broadcast 88 is output, recorded or otherwise utilized at home entertainment system 90, by generating viewer behavior information to indicate that the broadcast 88 was output, recorded or otherwise utilized at home entertainment system 90.

Id. at [0031]. EPGs are then updated and modified based on viewer behavior information. *See id.*, e.g., at [0044] (“once the viewing behavior information is received at the clearinghouse system 100, a processor 102 processes the information and/or makes the information available to modify the display of the EPGs of viewers in the system.”).

Thus, Goldman discloses a system in which viewer television habits are monitored, and those habits are compiled to update electronic program guides. The Applicants respectfully submit, however, that Goldman does not describe, teach or suggest “determining, at the first location, whether the associated set of pre-defined characteristics [associated with the **requested media**] matches the at least one parameter [related to monitoring media consumption activity of the user at the first location]; **sending notification of the media request** to a second location, via a communication network, if the determining results in a match; and **refraining from sending a notification of the media request** to the second location, via the communication

network, if the determining does not result in a match,” as recited in claim 1. **There simply is nothing in Goldman that describes, teaches or suggests sending notification of a media request to a second location if an associated set of pre-defined characteristics associated with the requested media matches a parameter related to monitoring media consumption activity of a user at a first location.** The Office Action has not shown where any cited reference describes, teaches or suggest such limitations. Thus, for at least these reasons, the Applicants respectfully submit that Goldman does not anticipate claims 1-8.

In response to the Applicants, the Office Action cites the following:

Goldman teaches tracking viewer behavior regarding the outputting, recording, etc. of a broadcasted video at a home entertainment system. An operator at a remote clearinghouse can determine the desired types of information to be included in the viewer behavior information. When a user at the home entertainment system requests a program from the program guide, predetermined characteristics of the program, i.e. channel ID, program ID, title, etc., are recorded. The remotely requested characteristics are matched against the characteristics recorded at the home entertainment system and when found, the matched data is sent to the clearinghouse. **If there is no match in a requested characteristic and a recorded characteristic, then the data is not sent to the clearinghouse (Para. 27-29, 35-37).** The claimed “media request” is taught by the viewing information containing, among a plurality of data, the channel ID, subscriber ID, program ID, and the current date and time. This shows the channel and program requested by the subscriber who requested it at the date and time it was requested. Therefore, the aforementioned limitation is taught by Goldman.

See November 25, 2008 Office Action at pages 3-4 (emphasis added). Thus, the Office Action relies on only paragraphs 27-29 and 35-37 to support the various statements above. Moreover, the Office Action equates “viewing information” with a “media request.” Further, the Office Action cites Goldman at reference 90 as the 1st location and reference 100 as the 2nd location. *See id.* at pages 3-4. The Applicants do not concede that these assumptions in the Office Action

equate to the claim limitations. Nevertheless, the Office Action reads claim 1, for example, as follows:

determining, at the first location **90**, whether the associated set of pre-defined characteristics [associated with the **viewing information**] matches the at least one parameter [related to monitoring media consumption activity of the user at the first location **90**];

sending notification of the **viewing information** to a second location **100**, via a communication network, if the determining results in a match; and

refraining from sending a notification of the **viewing information** to the second location **100**, via the communication network, if the determining does not result in a match.

As explained below, however, there is nothing in Goldman, however, that describes, teaches or suggests that a determination is made at the home entertainment system 90 as to whether a set of characteristics of the viewing information **matches** anything, let alone a parameter related to monitoring activity of a user at the home entertainment system.

Goldman discloses that the “[h]ome entertainment system 90 tracks each time broadcast 88 is output, recorded or otherwise utilized at home entertainment system 90, by **generating viewer behavior information** to indicate that the broadcast 88 was output, recorded or otherwise utilized at home entertainment system 90.” *See* Goldman at [0031]. Thus, Goldman clearly states that the home entertainment system **generates the viewer behavior information**, which the Office Action seemingly construes as a “media request.” However, there is nothing in Goldman that describes, teaches or suggests that the home entertainment system determines whether that viewer behavior information matches anything. Instead, the home entertainment system merely generated the viewer behavior information.

Goldman does disclose, however, that “[o]nce an event occurs, home entertainment system 90 couples the occurrence of the event with information specific to the program output, recorded, or otherwise utilized.” *See id.* at [0036]. Again, however, Goldman merely states that it generates viewer behavior information, but not that the system 90 determines whether that information **matches** anything.

As shown above, however, independent claim 1 specifically recites “determining, at the first location, whether the associated set of pre-defined characteristics [associated with the requested media] matches the at least one parameter [related to monitoring media consumption activity of the user at the first location]; **sending notification of the media request** to a second location, via a communication network, if the determining results in a match; and **refraining from sending a notification of the media request** to the second location, via the communication network, if the determining does not result in a match.” Thus, the claim is clear that if a determination is made **at the first location** that an associated set of **pre-defined characteristics** associated with requested media **match** at least one **parameter related to monitoring media consumption activity** of the user **at the first location**, then notification of **the media request** is sent to a **second location**. If there is no match, then no notification is sent.

As explained in detail above, Goldman merely discloses a system in which viewer television habits are monitored, and those habits are compiled to update electronic program guides. However, as shown above, the Office Action cites Goldman at ¶¶ [0027]-[0029] and [0035]-[0037] as somehow disclosing the limitations of claim 1 reproduced above. *See* November 25, 2008 Office Action at pages 3-4. In particular, the Office Action specifically relies on Goldman at ¶¶ [0036] and [0037] as disclosing “matching” predefined characteristics

associated with requested media with at least one parameter related to monitoring media consumption activity of the user at the first location. *See id.* at page 4.

While Goldman discloses that the “system tracks viewer behavior information at the television and transmits the tracked information in either real time or nearly so via a back channel,” there simply is nothing in Goldman at [0027]-[0029] that describes, teaches or suggests determining at a first location whether information regarding a media request matches anything. As noted above, the Office Action cites system 90 as the “first location” and the “viewer information” as a “media request.” Without conceding the propriety of these substitutions, as explained above, the Office Action has not shown that the system 90 determines if any match exists, let alone one between the viewer behavior information and anything else.

Moving on, Goldman at ¶ [0035] discloses the following:

Therefore, information **describing the viewing behavior (e.g., tuning, display, recording, scheduled recording, or setting a reminder) associated with particular television programs is tracked at home entertainment system 90.** The tracking may be initiated upon the occurrence of an event performed by a viewer of home entertainment system 90. In this description and in the claims, the term "event" encompasses an instructional input received by a home entertainment system, whereby video data corresponding to broadcast 88 is output, recorded or otherwise utilized at home entertainment system 90. The input may be entered by the viewer or some other source. The term "event" also extends to other changes in programming displayed on the home entertainment system without viewer input, one example being the beginning of a scheduled program on an already-tuned channel.

Id. at ¶ [0035] (emphasis added). This portion of Goldman merely describes that information describing viewing behavior, such as tuning, display, recording, scheduling, etc., is tracked at a home entertainment system. **Notably, the viewing behavior at the home is tracked at the home entertainment system. That is, the viewing and tracking occur at the same location.**

While this portion of Goldman discloses tracking viewing behavior at the same location as the viewing, it does not describe, teach or suggest “determining, **at the first location**, whether the associated set of pre-defined characteristics [associated with the requested media] **matches the** **at least one parameter** [related to monitoring media consumption activity of the user at the first location]; **sending notification of the media request to a second location**, via a communication network, if the determining results in a match; and **refraining from sending a notification of the media request to the second location**, via the communication network, if the determining does not result in a match,” as recited in claim 1. In general, this portion of Goldman, while disclosing tracking, does not describe, teach or suggest sending notification of a media request based on a determination of whether a match exists.

Next, Goldman at ¶ [0036] states the following:

Once an event occurs, home entertainment system 90 **couples** the occurrence of the event with information specific to the program output, recorded, or otherwise utilized. This may include, for example, **coupling** unique IDs from an EPG to an occurrence of an event. The IDs identify such information as the program viewed and the channel tuned. Thus, a processor 94 at home entertainment system 90 that is coupled with computer-executable instructions represents one example of means for generating viewer behavior.

Id. at ¶ [0036]. Thus, when an event, which is an “instructional input received by a home entertainment system, whereby video data corresponding to broadcast is output, recorded or otherwise utilized at the home entertainment system” (*see id.* at [0035]) occurs, the home entertainment system 90 **couples** the event with information specific to the program output, recorded or otherwise utilized. That is, **the home entertainment system merely connects the event with information regarding the program output**. Goldman does not describe, teach or suggest, however, that the home entertainment system **determines** if a **match** exists. Instead, it

merely discloses that the event is coupled to information. In general, this **coupling** of Goldman is a “means for generating viewer behavior.” Further, the “instructional input,” such as video data being output, recorded or otherwise utilized, **is an action, but not a request.**

Neither this portion, nor the remainder, of Goldman, describes, teaches or suggests “determining, at the first location, whether the associated set of pre-defined characteristics [associated with the requested media] **matches** the at least one parameter [related to monitoring media consumption activity of the user at the first location]; **sending notification of the media request** to a second location, via a communication network, if the determining results in a match; and **refraining from sending a notification of the media request** to the second location, via the communication network, if the determining does not result in a match,” as recited in claim 1.

Next, Goldman at ¶ [0037] states the following:

Depending on the type and volume of viewer behavior information that is desired to be tracked, **specific data corresponding to the broadcast can be requested remotely.** In general, the type of viewer behavior is at least sufficiently detailed to enable the system to determine the television program, if any, that is being displayed on the television. For example, the operator of central clearinghouse 80 to which the viewer behavior information is to be sent might decide that the desired types of information from the EPG that are to be included in the viewer behavior information are a channel ID, a subscriber ID, a program ID and title, the city and state of the channel, and the current date and time. Thus for each event, the foregoing information contained in the appropriate data fields of the EPG and information otherwise maintained at the home entertainment system is identified and stored as an instance of viewer behavior information.

Id. at ¶ [0037]. This portion of Goldman discloses that specific data corresponding to a broadcast can be requested, depending on the type and volume of viewer behavior. Information such as channel ID, subscriber ID, program ID, etc. may be stored. However, [0037], [0039],

and the rest of **Goldman** do not describe, teach or suggest that this “requested” data is in any way sent to another location based on a determination if a match exists between one set of information and another set of information. That is, this portion of Goldman does not describe, teach or suggest “determining, at the first location, whether the associated set of pre-defined characteristics [associated with the requested media] matches the at least one parameter [related to monitoring media consumption activity of the user at the first location]; **sending notification of the media request** to a second location, via a communication network, if the determining results in a match; and refraining from sending a notification of the media request to the second location, via the communication network, if the determining does not result in a match,” as recited in claim 1.

To summarize, the Office Action has not shown where any reference relied upon describes, teaches or suggests:

- **determining** at a **first location** whether a set of pre-defined characteristics associated with requested media matches a parameter related to monitoring media consumption activity of the user at the first location,
- sending notification of a media **request** (not consumption, *per se*, of the media) to a **second location** if the determination **results in a match**, or
- refraining from sending notification of a media **request** (not consumption, *per se*, of the media) if the determination **does not result in a match**.

Moreover, Goldman discloses that information about **every** “event” (viewing, recording, scheduling, etc.) is stored, and that **only certain information** about every stored event (i.e., all events that occur) is **sent to another location**. The Applicants respectfully submit that storing all events and sending back **only** information about **certain selected aspects of each and every**

event is different than only sending back information about certain events (i.e., requests for media whose “associated set of pre-defined characteristics” matches “at least one parameter”), as recited in the pending claims.

The Applicants reiterate that a “claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in **a single prior art reference.**” *Verdegaal Bros.*, 814 F.2d at 631, 2 USPQ2d at 1053 (emphasis added). Moreover, the “**identical** invention must be shown in as complete detail as is contained in ... the claim.” *Richardson* 868 F.2d at 1236, 9 USPQ2d at 1920 (emphasis added). As detailed above, however, Goldman does not describe, teach or suggest “each and every element” of the claims, nor does it show the “identical invention... in as complete detail as is contained in... the claim. The Applicants have demonstrated above that the portions of Goldman relied on by the Office Action do not describe, teach or suggest the limitations of claim 1, reproduced above. Thus, for at least these reasons, the Applicants respectfully request reconsideration of the claim rejections.

II. Goldman Does Not Anticipate Claims 9-18

Claim 9 recites, in part, “receiving, at the second location via the communication network, **notification of a media request** by the user, at the first location, the requested media having an associated set of pre-defined characteristics matching the at least one parameter.” For at least some of the reasons discussed above, the Applicants respectfully submit that Goldman does not anticipate claims 9-18.

III. Goldman Does Not Anticipate Claims 19-27

Claim 19 recites, in part, “the server software sending notification of a media request to a second location based on a determination as to whether a set of pre-defined characteristics associated with the requested media matches at least one parameter related to monitoring media

consumption activity at the first location.” For at least some of the reasons discussed above, the Applicants respectfully submit that Goldman does not anticipate claim 19-27.

IV. Claims 28-37

Claim 28 recites, in part, “the software sending notification of a media request to a second location based on a determination as to whether a set of pre-defined characteristics associated with the requested media matches at least one parameter related to monitoring media consumption activity at the first location.” The Applicants respectfully submit that Goldman does not anticipate claims 28-37 for at least some of the reasons discussed above.

VI. Conclusion

In general, the Office Action makes various statements regarding claims 1-37 and the cited reference that are now moot in light of the above. Thus, the Applicants will not address such statements at the present time. However, the Applicants expressly reserve the right to challenge such statements in the future should the need arise (e.g., if such statement should become relevant by appearing in a rejection of any current or future claim).

The Applicants respectfully request reconsideration of the claim rejections for at least the reasons discussed above. If the Examiner has any questions or the Applicants can be of any assistance, the Examiner is invited to contact the undersigned attorney.

The Commissioner is authorized to charge any necessary fees, or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Account No. 13-0017.

Respectfully submitted,

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